

### **REMARKS**

Claims 1-28 were originally filed in the present application. Claims 1-7 were subsequently canceled without prejudice or disclaimer, and new claims 29-35 were added. Claim 30 is currently canceled without prejudice or disclaimer. No other claims are currently canceled or added. Thus, claims 8-29 and 31-35 are currently pending in the present application.

Reconsideration of this application in light of the foregoing amendments and the following remarks is requested.

### **Rejections under 35 U.S.C. §112**

Claims 14 and 22 have been rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Examiner has alleged that “to prevent NESPD independent of a particular value added service [provider] for which NESPD is requested” contemplates subject matter which was not adequately described in the specification.

However, paragraph [0017] of the present application provides that “a user may disable their wireless device from transmitting location information to all requesters except emergency services providers (e.g., police and fire departments).” In other words, if a user can disable the transmission of location information to all requesters except emergency service providers, then the user can disable the transmission of location information to non-emergency service providers independent of a particular value added service provider for which NESPD is requested.

Similarly, paragraph [0020] of the present application provides that “status indicator 120 indicates a user-selectable preference for providing position information for ES but not for VASs,” and paragraph [0027] provides that a user can “disable the LCS capabilities of the wireless mobile device for all but EMERGENCY SERVICES LBSs.” Paragraph [0027] also provides that “the user may also wish to inform a PDE that the LCS capabilities of the wireless mobile device have been disabled for all but EMERGENCY SERVICES LBSs. The user of the wireless mobile device may do so by setting the EMERGENCY\_ONLY 120 status indicator to true.”

Accordingly, it is clear that the concept of preventing NESPD independent of a particular value added service provider for which NESPD is requested – that is, preventing NSDPD for all value added service providers – is fully supported by the present application. Consequently, it is believed that the written description requirement is fully satisfied, including with regard to claims 14 and 22.

Claim 30 has also been rejected under 35 U.S.C. §112. However, claim 30 is currently canceled without prejudice or disclaimer.

**Rejections under 35 U.S.C. §102**

**Claim 8**

Claim 8 recites:

8. A wireless communication system, comprising:  
a station having communication software for:  
receiving a capability request from at least one non-emergency-service-provider; and  
generating and transmitting a capability request response to each requesting non-emergency-service-provider that includes a status indicator of a non-emergency-services position-determination (NESPd) capability of the station, wherein the NESPd capability of the station is user-selectable to enable or disable all NESPd irrespective of which non-emergency-service-provider is associated with the capability request.

Claim 8 has been rejected under 35 U.S.C. §102(b) as being anticipated by Havinis.

The PTO provides in MPEP §2131 that:

*"[t]o anticipate a claim, the reference must teach every element of the claim...."*

Therefore, to sustain this rejection with respect to claim 8, Havinis must contain all of the elements of claim 8. However, among other elements, Havinis does not disclose generating and transmitting a status indicator of a non-emergency-services position-determination (NESPd) capability that is user-selectable to enable or disable all NESPd irrespective of which non-emergency-service-provider is associated with a capability request, at least in the context of claim 8. In direct contrast, Havinis explicitly discloses accepting or rejecting a positioning request based specifically upon the Location Application identity. (Column 6, lines 4-22). In other words, Havinis discloses accepting a positioning request respective of which Location Application is associated with the positioning request.

Therefore, the §102 rejection of claim 8 is not supported by Havinis. Consequently, Applicants respectfully request the Examiner withdraw the rejection.

Claim 14

Claim 14 recites:

14. A method of communicating between telecommunications network stations, comprising:  
receiving at a first station a capability request transmitted by a second station;  
generating at the first station a capability request reply in response to the capability request, wherein the capability request reply includes a status indicator of a non-emergency-services position-determination (NESPd) capability of the first station, the NESPd capability of the first station being user-selectable to either allow NESPd or prevent NESPd independent of a particular value-added-service-provider for which NESPd is requested; and  
transmitting the capability request reply to the second station.

Claim 14 has also been rejected under 35 U.S.C. §102(b) as being anticipated by Havinis. To sustain this rejection, Havinis must contain all of the elements of claim 14. However, Havinis does not disclose generating a status indicator of a non-emergency-services position-determination (NESPd) capability that is user-selectable to either allow NESPd or prevent NESPd independent of a particular value-added-service-provider for which NESPd is requested, at least in the context of claim 14. In direct contrast, Havinis explicitly discloses accepting or rejecting a non-emergency positioning request based specifically upon the Location Application identity. (Column 6, lines 4-22). In other words, Havinis discloses accepting a positioning request dependent of which Location Application is associated with the positioning request.

Therefore, the §102 rejection of claim 14 is not supported by Havinis. Consequently, Applicants respectfully request the Examiner withdraw the rejection.

Claim 22

Claim 22 recites:

22. A wireless mobile device, comprising:  
a user-interface configured for operation by a user in selecting a non-emergency-services position-determination (NESPd) capability of the wireless mobile device independent of non-emergency-service-provider entity;  
a generator configured to generate a signal comprising a status indicator of the NESPd capability and zero or more wireless mobile device native capability data; and  
a transmitter configured to transmit the signal to a wireless network element.

Claim 22 has also been rejected under 35 U.S.C. §102(b) as being anticipated by Havinis. To sustain this rejection, Havinis must contain all of the elements of claim 22. However, among other elements, Havinis does not disclose user-selection of NESPd capability independent of non-emergency-service-provider entity, at least in the context of claim 22. In direct contrast, Havinis explicitly discloses accepting or rejecting a positioning request based specifically upon the Location Application identity. (Column 6, lines 4-22). In other words, Havinis discloses user-selection of capability of accepting a non-emergency positioning request dependent of which Location Application is associated with the positioning request.

Therefore, the §102 rejection of claim 22 is not supported by Havinis. Consequently, Applicants respectfully request the Examiner withdraw the rejection.

Claim 29

Claim 29 recites:

29. A method of operating an element of a wireless communication network, comprising:  
transmitting a non-emergency-services position-determination (NESPД) message to a mobile station;  
receiving a status indicator from the mobile station, at least indirectly, wherein the status indicator indicates that the mobile station is configured to refrain from providing position information for non-emergency-services; and  
preventing a plurality of NESPД messages from being transmitted to the mobile station in response to receiving the status indicator.

Claim 29 has also been rejected under 35 U.S.C. §102(b) as being anticipated by Havinis. However, to sustain such a rejection, Havinis must contain all of the elements of claim 29. However, Havinis does not disclose: (1) transmitting a non-emergency-services position-determination (NESPД) message to a mobile station; (2) receiving a status indicator from the mobile station, at least indirectly, wherein the status indicator indicates that the mobile station is configured to refrain from providing position information for non-emergency-services; and (3) preventing a plurality of NESPД messages from being transmitted to the mobile station in response to receiving the status indicator.

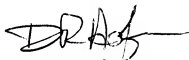
Therefore, the §102 rejection of claim 29 is not supported by Havinis. Consequently, Applicants respectfully request the Examiner withdraw the rejection.

**Conclusion**

It is clear from all of the foregoing that independent claims 8, 14, 22 and 29 are in condition for allowance. Dependent claims 9-13, 15-21, 23-28 and 31-35 depend from and further limit independent claims 8, 14, 22 and 29 and, therefore, are allowable as well.

It is believed that all matters set forth in the Office Action have been addressed, and that claims 8-29 and 31-35 are in condition for allowance. Favorable consideration and an early indication of the allowability of the claims are respectfully requested. Should the Examiner deem that an interview with Applicants' undersigned attorney would expedite consideration, the Examiner is invited to call the undersigned attorney at the telephone number indicated below.

Respectfully submitted,



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Dated: 7/7/06

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